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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/076,022 05/11/98 GOMAN

R 457.010US1

EXAMINER

MM32/0301

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ART UNIT

PAPER NUMBER

2876

DATE MAILED:

03/01/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/076,022

Applicant(s)

Goman et al

Examiner

Karl D. Frech

Group Art Unit

2876



☒ Responsive to communication(s) filed on Jan 5, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-35 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The amendment filed January 5, 2000 has been entered as paper number 6. By this paper, claims 10 and 26 have been amended. The references listed on the supplemental IDS have been considered. However, the two foreign English abstracts have been crossed through on the PTO 1449 because no date was provided as required.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4,827,425 in view of Laing et al 5,534,857. Linden discloses in column 3 line 52 - column 4 line 34 a multi station card personalization system. Each station has its own processor and buffer for programming or personalizing an IC card chip with information related to magnetically encoded data on a magnetic strip. The information to be written into the IC chip is delivered to the

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individual card station from a central controller. Although Linden discloses that the information to be written into the IC chip is related to the information on the previously encoded magnetic stripe of each card, Linden does not specifically disclose that the information on the magnetic stripe is read in order to initiate the transfer of data from the central controller to the individual card personalization station. Linden provides an "infeed" element where cards are first received by the personalization system. Linden does not disclose the security features as claimed. Laing discloses personalization of a card at a remote location. Laing discloses in column 4 lines 37+ that a security code is read from an un personalized card. The security code is then transmitted to and verified by a central administration system. Upon receiving a correct security code, the central administration system transfers personalization data to the individual remote card personalization terminal. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the security and information request teachings of Laing in the system of Linden. This would ensure that only a proper and authorized card were personalized by Linden, so that incorrect or "personal" data was not inadvertently transmitted to the wrong card.

#### REMARKS

4. Applicant's arguments filed January 5, 2000 have been fully considered but they are not persuasive.
5. The applicant argues that all the claimed features are not met because there is no card issuer management system disclosed by Linden or Laing. The examiner respectfully disagrees. As seen in claims 1,15,21 and 30, as acknowledged by applicant, there is the method step of

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“receiving a card object from a card issuer management system”. However, there is no specific apparatus of the card issuer management system claimed. That is, it is the step of receiving the card, not the actual management system itself which is claimed. Also, Linden provides an “infeed” element where cards are first “received” by the personalization system. (The examiner acknowledges that this element was not specifically elaborated upon in the previous action. However, it is clearly shown in the preferred embodiment of the base reference of Linden.)

6. The applicant argues the specified limitation that the card issuer management system manages the card holder data and determines the type of card to issue, the card applications to be embedded in the card, and what personalization equipment to use to issue the card for a particular cardholder. The examiner acknowledges that this may in fact be specified, and that the examiner must look to the specification to “define” the claimed elements. However, these elements themselves have not been claimed. The examiner must not read into the claim language, those limitations which are specified only. Further, as seen above, the management system itself is not physically claimed, only the act of receiving cards from a management system.

7. The applicant argues that Linden does not disclose any selective programming of the sort seen above. That is, Linden does not selective programming based upon what type of card is to issue, the applications to be embedded in the card and what personalization equipment to use to issue the card. Again, the examiner respectfully disagrees with this argument. There is no claimed limitation regarding the type of card to issue, the applications embedded in the card and the equipment used to personalized the card. The claims merely receiving a programming request

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from a personalization system. As seen in the rejection, Linden in view of Laing discloses programming a card in response to a request, i.e. the reading and correlation of the security code, the card is personalized.

8. The applicant argues that Linden and Laing fail to disclose variations in the personalization equipment. However, this “variation in personalization equipment” element is not claimed.

9. The applicant argues that there is no programming request in Linden. The applicant admits that Laing discloses a request. However, the applicant argues that Laing’s request is not a personalization request. The examiner respectfully disagrees. The request of Laing is operative to allow the card to be specifically programmed to operate for a cardholder. That is, upon the request from the personalization statement at a central location, the card is then programmed for the ultimate cardholder. The security code transmitted by Laing contains “information” allowing the programming of the card.

10. The applicant argues that an omission of an element in Laing makes the current invention simpler. The applicant elaborates on this argument. However, it is noted that the current claims are directed toward a programming method. Although the examiner concedes that certain, general apparatus elements may be inferred by the method steps, the apparatus is not specifically claimed. Therefore, the specifics of the apparatus is not claimed. Also, it is noted that the current claims use the open ended transitional phrase “comprising”. Therefore, although Linden and

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Laing may have more elements disclosed, the combined system of Linden and Laing encompass the currently claimed invention.

11. The applicant finally argues that a *prima facie* case has not been provided because all elements of the current invention have not been disclosed by Linden and Laing. The applicant relies upon the above arguments to support this statement. The examiner respectfully disagrees. As seen above, the combination of Linden and Laing provide for all the currently claimed elements.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Frech whose telephone number is (703) 305-3491. The examiner can normally be reached workdays from 8:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703) 308-7722.


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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karl.frech@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any fax transmission which may be intended as non-official for consideration by the examiner for interviews or other purposes should be clearly marked "DRAFT" and/or "COURTESY COPY" along with a statement to "DELIVER DIRECTLY TO EXAMINER". Such an un-official fax transmission must not be signed as it **will not** be entered into the application.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

  
Karl Frech  
Examiner, AU 2876  
February 25, 2000

  
Donald Hajec  
Supervisory Patent Examiner  
Technology Center 2800